



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 09 2004

GROUP 3600

In re the Application of

Ballard

Serial No. 09/454,492

Group Art Unit: 2164

Filed: December 6, 1999

Examiner: Weisberger

For: Remote Image Capture with Centralized Processing and Storage

RESPONSE TO REQUIREMENT FOR INFORMATION

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed June 18, 2003, Applicant respectfully presents his response to the Requirement for Information in that Office Action.

The Examiner required information regarding patent infringement suits against parties named RDM, EDS, and Viewpointe Archive Services. Specifically, the Examiner required identification of the alleged infringing devices, and all depositions, interrogatories, and pleadings that discuss the alleged infringing devices.

Applicant encloses the following documents in response to this request:

1. Complaint in *DataTreasury Corp. v. Electronic Data Systems Corp.*, Cause No. 3-02CV2643-M, In the United States District Court for the Northern District of

Texas, Dallas Division, in which the EDS NetDeposit® Digital Check Processing system is identified as an accused infringing device.

2. Complaint in *DataTreasury Corp. v. RDM Corp. a.k.a. Research Development and Manufacturing Corp.*, Cause No. 3-02CV2641-M, In the United States District Court for the Northern District of Texas, Dallas Division, in which the electronic check conversion and payment archive systems of RDM Corp. are identified as accused infringing devices.
3. Complaint in *DataTreasury Corp. v. Viewpointe Archive Services, L.L.C.*, Cause No. 3-02CV2642-N, In the United States District Court for the Northern District of Texas, Dallas Division, in which the check image archive technology of Viewpointe Archive Services, L.L.C. are identified as accused infringing devices.

On information and belief, the accused infringing devices and products of EDS include the EDS NetDeposit® Digital Check Processing system noted in the Complaint, the accused infringing devices and products of RDM Corp. included their Payment Archive service and their check imagers and scanners, and the accused infringing products of Viewpointe Archive Services include the imaging archive systems and services provided by Viewpointe Archive Services.

On information and belief, the litigation against RDM Corp. has settled, with RDM agreeing to a license under the asserted patents on June 3, 2003.

Further in the spirit of full compliance with the Request for Information, Applicant wishes to advise the Patent and Trademark Office of additional litigation involving U.S. Patent No. 6,032,137 and U.S. Patent No. 5,910,988, through which this application claims priority. To this end, Applicant enclosed copies of the following complaints:

1. Complaint in *DataTreasury Corp. v. Bank One Corp.*, Cause No. 3-03CV0059-K, In the United States District Court for the Northern District of Texas, Dallas

Division, in which the check processing and check imaging systems of Bank One are identified as accused infringing devices.

2. Complaint in *DataTreasury Corp. v. First Data Corporation, et al.*, Cause No. 502CV094, In the United States District Court for the Eastern District of Texas, Texarkana Division.
3. Complaint in *DataTreasury Corp. v. Ingenico S.A., et al.*, Cause No. 502CV095, In the United States District Court for the Eastern District of Texas, Texarkana Division.
4. Complaint in *DataTreasury Corp. v. J.P. Morgan Chase & Co., et al.*, Cause No. 502CV124, In the United States District Court for the Eastern District of Texas, Texarkana Division.

In addition, according to the local rules of the Texarkana Division of the Eastern District of Texas, plaintiff DataTreasury Corp. has submitted Preliminary Infringement Contentions to the Court in each of the First Data, J.P. Morgan Chase, and Ingenico lawsuits. These Preliminary Infringement Contentions specify particular claims of the patents in suit, and the specific “accused instrumentalities” that are alleged to infringe those claims. In this regard, Applicant encloses copies of the following documents:

1. Disclosure of Asserted Claims and Preliminary Infringement Contentions in *DataTreasury Corp. v. First Data Corporation, et al.*, Cause No. 502CV094, In the United States District Court for the Eastern District of Texas, Texarkana Division.
2. Plaintiff’s First Amended Disclosure of Asserted Claims and Preliminary Infringement Contentions in *DataTreasury Corp. v. First Data Corporation, et al.*, Cause No. 502CV094, In the United States District Court for the Eastern District of Texas, Texarkana Division.

3. Disclosure of Asserted Claims and Preliminary Infringement Contentions in *DataTreasury Corp. v. Ingenico S.A., et al.*, Cause No. 502CV095, In the United States District Court for the Eastern District of Texas, Texarkana Division.
4. Plaintiff's Initial Disclosure of Asserted Claims and Preliminary Infringement Contentions in *DataTreasury Corp. v. J.P. Morgan Chase & Co., et al.*, Cause No. 502CV124, In the United States District Court for the Eastern District of Texas, Texarkana Division.

The undersigned understands that the restriction "Confidential - for Outside Counsel Only" designation on these documents is no longer operative.

On information and belief, one of the parties in the *J.P. Morgan Chase & Co.* litigation, namely Affiliated Computer Services, Inc., has agreed to a permanent injunction from practicing the asserted patents.

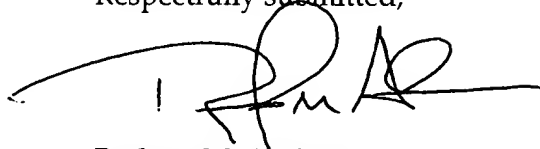
Further in the spirit of the duty of disclosure, Applicant will soon be filing, under separate cover, a Supplemental Information Disclosure Statement citing many prior art references that various ones of the parties defendants in these lawsuits have submitted in support of invalidity defenses. This Supplemental Information Disclosure Statement will also provide documents filed by these defendants specifying those assertions that the patents in suit are invalid.¹

Applicant submits that this response is a good faith effort toward fulfilling the Requirement for Information. The Patent and Trademark Office is urged to call the undersigned if there are any questions about this submission.

¹ MPEP §2001.06(c).

Continued consideration of this application is respectfully requested.

Respectfully submitted,



Rodney M. Anderson

Registry No. 31,939

Attorney for Applicant

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CERTIFICATE OF MAILING

37 C.F.R. 1.8

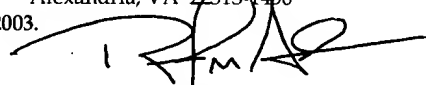
The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an enveloped addressed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

on December 17, 2003.



Rodney M. Anderson

Registry No. 31,939



3624 \$

PTO/SB/17 (10-03)

Approved for use through 07/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 740

Complete if Known

Application Number 09/454,492

Filing Date December 6, 1999

First Named Inventor Ballard

Examiner Name Weisberger

Art Unit 3624

Attorney Docket No. Data.P01CIPDIV

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JAN 09 2004

GROUP 3600

METHOD OF PAYMENT (check all that apply)☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:Deposit
Account
Number
Deposit
Account
Name

01-1615

Anderson, Levine & Lintel

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$) --

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims		Fee from below	Fee Paid
Total Claims	<input type="text"/>	-20** =	<input type="text"/>	X	<input type="text"/>
Independent Claims	<input type="text"/>	-3** =	<input type="text"/>	X	<input type="text"/>
Multiple Dependent				<input type="text"/>	<input type="text"/>

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$) --

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	740
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 740

SUBMITTED BY

(Complete if applicable)

Name (Print/Type)

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Registration No.
(Attorney/Agent)

31,939

Telephone 972-664-9554

Signature

[Signature]

Date

17 Dec. 2003

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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